

As discussed in MPEP §2142, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. Three criteria must be met :

(1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings.

(2) There must be a reasonable expectation of success.

(3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488.

Claims 1, 51, 52, and 53 recite "means for storing financial information of the user" and "transmitter means ... for ...transmitting the financial information of the user to the receiver unit at the remote location".

Johnson et al. is concerned with a remote control system that can control both a CATV system (300) and a digital music tuner (100). Although Figure 6 discloses a "buy" button, the button would only result in a indication signal being sent to the receiver to perform some action. In contrast, claim 1 discloses that an intelligent signal is sent from the remote unit to the receiver unit which includes the financial information of the user.

Hughes et al. disclose a terminal 10 which is hardwired through a modem and phone line to a host computer 80. Applicant respectfully traverses a combination between Johnson et al and Hughes et al.

First, under the third prong of the obviousness test, Johnson et al. actually conflicts with Hughes et al. Under MPEP §2143.01, where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might actually discredit another. *In re Young*, 927 F.2d 55 (Fed. Cir. 1991). Johnson et al. discusses in col. 2, lines 35-50 the problems with separate display units. One of the problems Johnson et al. cite is the difficulty with long cables. "Long cables for the display would be difficult to route in a typical living room, and one need only look at the lack of success of video cassette recorder (VCR) wired remote controls to convince oneself that such a tethered display would not be optimum." Since a reference must be examined in its entirety and Hughes et al. disclose implementing the point of presence device using a cable the references conflict. Therefore, it is respectfully submitted that to someone of ordinary skill in the art looking at the Johnson et al. reference, the Hughes et al. reference would not readily suggest itself.

Second, the Hughes et al. reference expresses a concern with security of the transmission by using an encryption key (col. 4, lines 56-65). However, Johnson et al. is a wireless device which would mean the signal could be picked up by an external device in the same manner as a portable phone. "A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the references would be discouraged from following the path set out in the reference or would be led in a direction divergent from the path the applicant took." *In re Gurley*, 27 F.3d 551 (CAFC 1994). One of ordinary skill in the art looking at Hughes et

al. would not think of using a wireless device since it would cut away from the security considerations of the invention disclosed in Hughes et al.

Therefore, it is respectfully submitted that claim 1 is allowable over the cited references. Since claims 2-4, 6-9, and 46-47 are dependent on claim 1 they are also believed to be allowable over the cited references.

Claim 55 includes all the limitations of claim 1, however, it has been further amended to recite “[a] device for controlling an interactive receiver unit in a cable system”. Although Johnson et al. disclose the use of a remote in a cable system, it does not disclose the transmission of final information over the remote. It would not have been obvious to combine this with Hughes et al. because Hughes et al. is concerned with a point of presence device and does not have anything to do with a cable system. “Prior art references must be either in the field of the inventor’s endeavor or reasonably pertinent to the specific problem with which the inventor was involved.” *In re Deminski*, 796 F. 2d 346.

CONCLUSION

For the reasons discussed above, it is respectfully submitted that claims 1-4 and 6-55 are allowable over the cited references.

If a telephone conference would expedite the prosecution of the application in any manner, the Examiner is requested to contact the undersigned attorney.

AUTHORIZATION

The Assistant Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account 13-4500, Order No. 1029-4012US3.

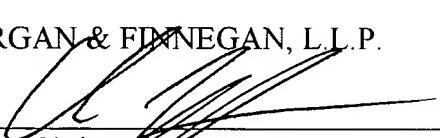
In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Assistant Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 1029-4012US3. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

Dated: September 9, 1999

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